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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,213	11/20/2003	Jillian Jacobson-Alti	1422-2U	9010
31292 7590 09/10/2007 CHRISTOPHER & WEISBERG, P.A. 200 EAST LAS OLAS BOULEVARD SUITE 2040 FORT LAUDERDALE, FL 33301			EXAMINER MERCIER, MELISSA S	
			ART UNIT 1615	PAPER NUMBER
			MAIL DATE 09/10/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/718,213	<b>Applicant(s)</b> JACOBSON-ALTI, JILLIAN	
	<b>Examiner</b> Melissa S. Mercier	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1, 2 and 5-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8-10-07</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 10, 2007 has been entered.

### **Summary**

Claims 1-17 are pending in this application. Claims 3-4 remain withdrawn from consideration. In view of Applicants arguments, claims 5-6 and 11-17 have been rejoined to claim Claims 1-2 and 7-10, therefore, claims 1-2 and 5-17 are now under prosecution in this application.

### ***Claim Objections***

Claims 7-10 and 13-14 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1, from which claims 7-10 depend was amended to incorporate the limitations of claims 7-10.

Claims 13-14 present ranges which broaden the amount of the flavorant and odorant in the compositions.

Claim 14 is further objected to because of the following informalities: there appears to be a typo in the claim, the range of flavorant recited reads 0.0005 to **0.E**, based on the terminology employed in the previously presented claims, the examiner is interpreting the E to be a 5. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2 and 5-17 rejected under 35 U.S.C. 103(a) as being unpatentable over Shanni (US Patent 5,631,012) in view of Deckers et al. (US Patent 6,372,234).

Shanni discloses lip pomade comprising 5.00% ozokerite, 10.00% isopropyl myristate, and a fragrance/flavor portion (Example 6). Pomade is defined as a perfumed oil or ointment by dictionary.com and would therefore be considered a liquid formulation.

Shanni does not disclose the use of a colorant, preservative, in the formulation

Deckers teach a cosmetic composition comprising oil bodies suitable for use in lipsticks, lip-glosses, lip balms and lip pencils.

Deckers cosmetic composition further comprises fragrances. Deckers defines a fragrance as any component reacting with the human olfactory sites and imparting a pleasurable odor, essence, or scent. Fragrances taught by Deckers include linear and

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cyclic alkenes, primary, secondary, and tertiary alcohols, ethers, esters, ketones, nitrites, and saturated and unsaturated aldehydes" (column 17, lines 18-52).

The use of a preservative in order to treat against contamination by bacteria, fungi and viruses is disclosed (column 13, lines 21-26).

Deckers further discloses the addition of pigments, including titanium dioxide, zinc oxide, black, yellow, red and brown iron oxides, for example (column 22, lines 47-56); antioxidants, including plant extracts (column 23, lines 1-12).

Deckers teaches the use of esters including C<sub>8</sub>-C<sub>30</sub> alkyl esters of C<sub>8</sub>-C<sub>30</sub> carboxylic acids; C<sub>1</sub>-C<sub>6</sub> diol monoesters and diesters of C<sub>8</sub>-C<sub>30</sub> carboxylic acids; C<sub>10</sub>-C<sub>20</sub> alcohol monosorbitan esters, C<sub>10</sub>-C<sub>20</sub> alcohol sucrose di- and tri- esters; C<sub>10</sub>-C<sub>20</sub> alcohol sucrose mono-, di-, and tri- esters; and C<sub>10</sub>-C<sub>20</sub> fatty alcohol esters of C<sub>2</sub>-C<sub>6</sub> 2 hydroxyacids, examples included sorbitan esters (column 16, lines 41-53). It is the examiners position that since sorbitan esters are disclosed and it is known in the art that they are useful in cosmetic formulations, it would have been obvious to substitute on for another with the expectation that they would function similarly.

The instant claims differ from the references only in the specific percentage selected for the compositions. However, It would have been deemed prima Facie obvious to one having ordinary skill in the art at the time of the invention to optimize the percentage of bodying agents, odorants, and flavorants to prepare a composition containing for topical treatment to the lips because the determination of a specific percentage having the optimum therapeutic effect is well within the level of one having ordinary skill in the art, and the artisan would be motivated to determine optimum

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amounts to get the maximum effect of the active compounds. Therefore, the invention as a whole has been prima facie obvious to one of ordinary skill in the art at the time the invention was made.

It is generally considered to be prime facie obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. As shown by the recited teachings, instant claims are no more than the combination of conventional components of commonly known to be used in the art of lip stick/gloss compositions. It therefore follows that the instant claims define prime facie obvious subject matter. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues the Shanni reference requires vernix as an essential material to improve skin softness, flexibility, plasticity and moisturization. While the examiner agrees the Shanni employs a synthetic vernix material, Shanni discloses it to be useful for its moisturizing properties. The instant claims recite the use of an alkyl ester, which is art recognized as an emollient, a moisturizing component. Therefore, the instant claims recognize the need for a moisturizing property of the lip care formulation. Furthermore, no evidence has been submitted that would show the removal of the

particular moisturizer taught by Shanni would have a negative effect on the composition to function for application to the lips.

### ***Conclusion***

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

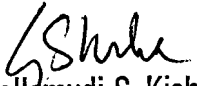
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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